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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,738	11/07/2001	John W. Ladd	4584. IUS (00-0787.1)	4327
24247	7590	05/06/2004	EXAMINER	
TRASK BRITT			CHANG, RICK KILTAE	
P.O. BOX 2550			ART UNIT	PAPER NUMBER
SALT LAKE CITY, UT 84110			3729	

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/035,738

Applicant(s)

LADD, JOHN W.

Examiner

Rick K. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/15/04 has been entered.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9 and 11-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure, as originally filed, fails to provide support for "a temporary electrical contact with at least one semiconductor device", "establishing temporary . . . device", "permitting and . . . as the temporary electrical contact is maintained", and "magnetically drawing . . . to maintain the temporary electrical contact" (claims 1 and 8).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-9 and 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 8 includes limitations to a particular electrical connectivity using time frame as follows: "a temporary electrical contact with at least one semiconductor device", "establishing temporary . . . device", "permitting and . . . as the temporary electrical contact is maintained", and "magnetically drawing . . . to maintain the temporary electrical contact". The time frame of the connectivity cannot be determined without knowing what is "permanent" time frame relative to "temporary", and the patent record discloses as being they are permanently connected. They render the claims vague and indefinite as well as competitors would be unable to discern the bounds of the invention.

NOTE: no rejection is given to the limitations "a temporary electrical contact with at least one semiconductor device", "establishing temporary . . . device", "permitting and . . . as the temporary electrical contact is maintained", and "magnetically drawing . . . to maintain the temporary electrical contact".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-9 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Degani et al (US 6,370,766) in view of Butherus et al (US 3,612,955), and further in view of Official Notice.

Degani discloses electrically testing during burn-in testing the plurality of electrical components by applying test signals to the width linear array of electrical contacts, which includes heating the components to an elevated temperature while applying an electrical bias to the components.

Degani fails to disclose magnetically drawing at least one of the first member and the at least one contact toward the other of the first member and the at least one contact as well as burn-in testing either heating cycling or variously as disclosed in claims 1-9 and 11-20.

Butherus discloses in Figs. 1A-1B and 2 a semiconductor device 59 surrounded with ferromagnetic materials to provide attraction both vertically and laterally.

Official Notice is taken that it is well known in the art to provide during burn-in testing heat is provide either cycling or variously to purposely fail the component.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Butherus by magnetically drawing at least one of the first member and the at least one contact toward the other of the first member and the at least one contact as well as burn-in testing either heating cycling or variously as disclosed in claims 1-9 and 11-20, as taught by Butherus and Official Notice, for the purpose of properly aligning the components to the assigned electrical pads and determining whether the components are functioning properly or not before the final assembly is performed to improve customer satisfaction.

***Response to Arguments***

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8. Applicant's arguments with respect to claims 1-9 and 11-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Please provide reference numerals (either in parentheses next to the claimed limitation or in a table format with one column listing the claimed limitation and another column listing corresponding reference numerals in the remark section of the response to the Office Action) to all the claimed limitations as well as support in the disclosure for better clarity (optional). Applicants are duly reminded that a full and proper response to this Office Action that includes any amendment to the claims and specification of the application as originally filed requires that the applicant point out the support for any amendment made to the disclosure, including the claims. See 37 CFR 1.111 and MPEP 2163.06.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick K. Chang whose telephone number is (703) 308-4784. The examiner can normally be reached on 5:30 AM to 1:30 PM, Monday through Thursday.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.



RICHARD CHANG  
PRIMARY EXAMINER

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May 3, 2004